REMARKS

Applicants submit this Amendment After Final in reply to the final Office Action mailed November 24, 2004 and Advisory Action mailed February 9, 2005.

By this Amendment After Final, Applicants propose to amend independent claims 11 and 45 to further define the invention, and to cancel claim 61. The originally filed specification and drawings fully support the proposed amendments to independent claims 11 and 45. No new matter has been introduced. If this Amendment After Final is entered, claims 11, 45, 47-57, 59, 60, 62-65, 67, and 68 will be pending in this application.

On pages 2-6 of the final Office Action, claims 11, 45, 48, 50-53, and 61 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,666,883 to Seguin et al. ("Seguin") in view of U.S. Patent No. 5,968,052 to Sullivan et al. ("Sullivan"); claims 47 and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seguin in view of Sullivan and further in view of U.S. Patent No. 5,810,837 to Hofman et al. ("Hofman"); claims 54, 55, 62, and 63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seguin in view of Sullivan and further in view of U.S. Patent No. 5,306,294 to Winston et al. ("Winston"); and claims 56, 57, 59, 60, 64, 65, 67, and 68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seguin in view of Sullivan and Winston, and further in view of U.S. Patent No. 5,100,381 to Burns ("Burns"). Claim 61 has been cancelled, rendering its rejection moot. With respect to the rest of the claims, Applicants respectfully traverse the rejections and assert that none of Seguin, Sullivan, Winston, Hofman, or Burns, either individually or in combination, recite every aspect of the claimed invention for at least

the reasons set forth in the Request for Reconsideration After Final filed January 19, 2005.

Applicants first summarize the reasons set forth in the Request for Reconsideration. Page 2 of the final Office Action appears to assert that the abutment described in col. 5, lines 28-34 of Seguin corresponds to the "external tubular structure contact area" of each of claims 11 and 45. That portion of Seguin, however, is the only reference to the abutment, and does not disclose or suggest that the abutment is "proximal to" the device 1, and it is not inherent in Seguin that the abutment is so positioned. As detailed in the January 19, 2005 Request for Reconsideration, it is likely that the abutment in Seguin is located ***distal*** to the device 1 when the device 1 is radially contracted around core 15, so that device 1 would not slide distally out of sheath 16 during insertion of the entire assembly to the treatment site, for example. Indeed, if the abutment in Seguin were proximal to device 1, the diameter of the abutment would not have to be less than the diameter of the expanded device 1, as recited at col. 5, lines 30-32 of Seguin, because the abutment would not have to be removed through expanded device 1.

Page 2 of the final Office Action admits that "Seguin fail to disclose a translucent region at the distal end of the outer tubular structure 16." The Advisory Action then asserts, however, that it would have been obvious to modify the outer tubular structure 16 of Seguin to include the translucent retractable outer sheath 14 of Sullivan, between radiopaque rings 21 and 22 of Seguin, for example, and that such a translucent region would have a length less than the constrained length of stent 1, meeting that aspect of each of claims 11 and 45. As also detailed in the Request for Reconsideration, even

assuming that the retractable outer sheath 14 of Sullivan corresponds to the "the outer tubular structure [having] a translucent region at the distal end," no embodiment in Sullivan discloses that the retractable outer sheath 14 has a length less than the length of the stent 18. For example, the length of the region between marker bands 36 and 28 is longer than the constrained length of stent 18, as clearly shown in Fig. 3 of Sullivan. Accordingly, even assuming *arguendo* that the combination of Seguin and Sullivan is proper, the combination would result in the outer tubular structure 16 of Seguin having a translucent region which has a length greater, not less, than the length of device 1. Indeed, the selective placement of the translucent region of Sullivan between any of radiopaque markers 20, 21, 22 of Seguin is arbitrary.

In response to Applicants' arguments, the Advisory Action asserts that even if "the stent of Seguin et al. is located proximally with respect to the abutment shoulder..., then the area just distal to the abutment shoulder may be considered to be the claimed stent accommodating area since this area can inherently accommodate a stent therein." (Advisory Action, p. 2). The Advisory Action further asserts that by making translucent the region of the outer tubular surface 16 between radiopaque markers 21 and 22 in Seguin, the aspect of a "translucent region [having] a length less than a constrained length of a stent" as recited in each of independent claims 11[1] and 45 would be met.

As an initial matter, Applicants respectfully disagree that the area distal to the abutment shoulder is inherently a stent accommodating area, as the Advisory Action has not provided any evidence, extrinsic or otherwise, showing how the area distal to

[1] We note that the Advisory Action refers to claim 1, which is cancelled. We understand the Examiner to refer to claim 11.

the abutment shoulder is inherently capable of accommodating a stent, as required by M.P.E.P. § 2112(IV). "To establish inherency, the extrinsic evidence 'must make clear that missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original). As the Advisory Action does not cite any evidence, extrinsic or otherwise, to show that the area distal to the abutment shoulder may accommodate a stent, and it does not necessarily flow from the reference that the distal area may accommodate a stent, the requirements for showing inherency have not been met.

Regardless, however, Applicants have amended each of claims 11 and 45 to recite the "translucent region is coextensive with at least a portion of the stent accommodating area." Each of these claims also positively recites a stent in the stent accommodating area. Thus, even assuming that the area distal to the abutment member of Seguin is considered a stent accommodating area, that area is not coextensive with the region of the outer tubular structure 16 between radiopaque markers 21 and 22, the alleged "translucent region" in Seguin. And, that area (i.e., the area distal to the abutment member) is not disclosed in Seguin as including a stent. Moreover, even if that area was made translucent, there is no further teaching or suggestion in Seguin that such a translucent region has a length less than the length of

the stent. Accordingly, the references do not disclose each and every aspect of the claimed invention, and thus Applicants respectfully request withdrawal of the Section 103(a) rejections.

Furthermore, none of Winston, Hofman, or Burns remedy at least the aformentioned deficiencies of Seguin and Sullivan. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejections.

Claims 47-57, 59, 60, 62-65, 67, and 68 depend from one of independent claims 11 and 45, and are therefore allowable for at least the same reasons that each of those respective independent claims is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by Seguin, Sullivan, Winston, Hofman, or Burns, or other cited art, and therefore are separately patentable.

Applicants respectfully request that this Amendment After Final under 37 C.F.R. § 1.116 be considered by the Examiner, placing claims 11, 45, 47-57, 59, 60, 62-65, 67, and 68 in condition for allowance. This Amendment After Final does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment After Final should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final Office Action and the Advisory Action presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entry and consideration of the Amendment After Final would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry and consideration of this Amendment After Final, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The final Office Action and Advisory Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in either the final Office Action or the Advisory Action. For example, on pages 3-4 of the final Office Action, the Examiner asserts that certain features of claim 52 are admitted to be in the prior art. Applicants do not necessarily agree with that assertion and reserve the right to refute the assertion should the need arise. As another example, page 3 of the final Office Action, which refers to claim 51, asserts:

> Seguin et al. fail to disclose the steps of retracting the stent back into the outer tubular structure and then repositioning the stent delivery system. However, retracting the Seguin et al. stent back into the outer tubular structure and then repositioning the stent delivery system when it is determined that the stent is not initially properly positioned would have been obvious since it was well known in this art to so retract and reposition stents for this reason.

Applicants respectfully disagree with this statement as to what is allegedly well known and again respectfully request that the Examiner provide evidence to support this assertion.

In discussing the specification and claims in this Amendment After Final, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in

the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment After Final and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: _____
Michael W. Kim
Reg. No. 51,880